UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,295	10/28/2003	Lawrence Morrisroe	085804-010801	5110

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EXAMINER
RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 January 2010*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28 and 31-33* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28 and 31-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

This office action is in response to Request for Continued Examination filed January 19, 2010. Claims 1, 11, 16, 18, 24, 28, 32 and 33 are amended. Claims 1-28 and 31-33 are still pending.

Requirements for Information

37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under'1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(I)   Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii)   Search: Whether a search of the prior art was made, and if so, what was searched.

(iii)   Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv)   Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v)   Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention

process, such as by designing around or providing a solution to accomplish an invention result.

(vi)   Improvements: Where the claimed invention is an improvement, identification of what is being improved. (vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2)   Where an assignee has asserted its right to prosecute pursuant to' 3.71 (a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3)   Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b)   The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c)   A reply, or a failure to reply, to a requirement for information under this section will be governed by " 1.135 and 1.136.

The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is where the claimed invention is an improvement, identification of what is being improved and identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use. And information used in drafting the present operation including information related to the field of endeavor or business practices used by applicant's

professional business ventures, to show the information used in the invention process, and

identification of any use of the claimed invention known to the inventor at the time the

application was filed notwithstanding the date of the use. Since the application is filed as a large

entity status with Yahoo as assignee and along with the fact that the inventor submitted no IDS

regarding Macromedia Flash, it appears that it would be appropriate to require the applicants to

provide information necessary to ensure a quality examination to be performed by the Office.

According to the articles (Yahoo! Flash Banner Ads, Flash ad on Yahoo!, Yahoo! Xtra Flash

Banner Ads, etc), Examiner believes that the assignee is aware of the Macromedia Flash, which

is part of the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7-12, 24-27 and 31-33 are rejected under 35 U.S.C. 102(b) as being

anticipated by DoubleClick, as disclosed in DoubleClick International, 1/08/2001;

(http://demo.doubleclick.com/generators/docs/designer_version.pdf) hereinafter DoubleClick.

Regarding claim 1, DoubleClick teach *combining at a server* an ad input file (Flash file,

FLASH banner ads, FLASH movie) with a conduit file *(clickButton, on (release) (getURL*

(clickTag, "blank") (see fig.1 or fig.2), separate from the ad input file, automatically create a

single integrated ad file having a single file extension (swf file) *from the ad input file and the*

separate conduit file using a merge tool (ActionScript used to combine the clicktag together

with the movie) prior to the server serving the integrated ad file; wherein the conduit file

comprises of computer code (ClickTag) for tracking data for the ad, and serving the integrated

ad file from a computer to provide the ad (see pp 1-3);

Regarding claim 4, DoubleClick teaches the use of Macromedia Flash; wherein the ad is

Flash ad and the files are "swf" files (see pp 1-3)

Regarding claims 7-10, DoubleClick teaches the ad including one or more actions for

linking to one or more web pages and wherein the ad input file specifies one or more button

actions, each having an exit code ...; the integrated ad file includes html code loading a

JavaScript file, for loading the integrated ad file; tracking the ad using the code in the conduit file

and tracking identifier; the html code including a variable and the conduit file includes code that

determined where the ad opens in a parent window or new window based on the variable (see pp

3).

Regarding claims 11, 12 and 24-27, DoubleClick teaches identifying a first file (Flash

movie file); identifying a second file *clickButton, on (release) (getURL (cilickTag1, "blank")*

(tracking string (ClickTag)) *separate from the first file* ; wherein the first file specifies ad content

code and the second file contains ad-tracking code; electronically inserting the second file into a

placeholder (frame) to create a file having a single file extension (swf); wherein the first file

specifies ad content code and the second file contains an ad-tracking code (code to identify

tracking data)(see pp 1-3).

Regarding claims 31 and 32, DoubleClick teaches the integrated ad file includes one or

more exit code referring to one or more URL variables; wherein the integrated ad file is designed

to be loaded *by a code in addition to the computer code*, and wherein the ad is provided (see pp
2-3).

Regarding claim 33, DoubleClick teaches the ad is provided to a user computer via the

Internet and combining of the files is in response to receiving a request for a Web page and

serving the integrated ad file as par of the web page (see pp 2&3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 2, 3, 13, 14, 22, 23 and 28 are rejected under 35 U.S.C. 103(a) as being

unpatentable over DoubleClick, as applied to claim 1 above, in view of Official Notice.

Regarding claims 2, 3, 13, 14, 22, 23 and 28, DoubleClick teaches each time the

destination URL has to be modified (for whatever reason) the FLASH file has to be sent back to

the design agency to be modified. DoubleClick also teaches by using variables to pass the click

tracking string into Flash movies instead of modifying the FLASH file itself only the variable in

the Rich Media Field is changed. Therefore, it would have been obvious to one of ordinary skill

in the art at the time of the invention to known that the designer or programmers of DoubleClick

would accept a new or modified information or content from the source and insert the same or

different tracking information according to the goals of the campaign or the preference of the

tracking server.

Claims 5, 6 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

DoubleClick in view of Macromedia Flash Advanced for Windows an Macintosh: Visual

QuickPro Guide by Russell Chun May 8, 2002 first edition (hereinafter Chun).

Regarding claims 5, 6, 15-21, DoubleClick teaches identifying a first file *clickButton, on*

(release) (getURL (cilickTag1, "blank") for tracking string (ClickTag1); identifying a second

file (*(clickButton, on (release) (getURL (cilickTag2, "blank"*) for tracking string (ClickTag2))

(see last paragraph of pp. 3), *different than the first file*; identifying a third file (Flash movie)

different than the first and second file. DoubleClick does not explicitly teach placeholders for the

files. However Chun teaches that Flash includes empty placeholders and also teaches that

placeholder means the end of the movie, and that there are no more frames available to display

(see pp. 77-79, 97, 173). It would have been obvious to one of ordinary skill in the art at the time

of the invention to know that placeholders would be used for the files, since Flash frames are

used to create the movie. In Flash, a placeholder is just an empty frame which has no content and

when a movie created using Flash reaches an empty frame it stops playing . Therefore, it would

have been obvious to one of ordinary skill in the art at the time of the invention for identifying a

first placeholder and second placeholder in the third file and electronically inserting the first and

second file into the first and second placeholder respectively to create a single integrated ad file

having a single file extension (swf); wherein the first file includes a tracking data; html code

loading ad file (third file); third file including one or more buttons; anyplace where the

ClickTag1 and ClickTag2 is considered a placeholder (see pp 1-3).

Response to Arguments

Applicant's arguments filed July 21, 2009 have been fully considered but they are not persuasive.

Applicant asserts that "DoubleClick describes the details for a person to edit an ad Flash file to create an ad Flash file that is compliant with DoubleClick's DART system. According to the instructions provided in DoubleClick, a person, referred to as a designer in DoubleClick, must edit the ad Flash file to include a "clickTag" variable, and select a setting to indicate to the ActionScript that the variable is to be evaluated as an expression. At page 1, DoubleClick describes that its tracking method provided by the DART system uses the "clickTag" variable to pass a click tracking string into the Flash movie. Once the person makes the edits to the ad Flash file to create an ad Flash file that is compliant with the DART system, the destination URL and click tracking string can be changed at the DART system without changing the ad Flash file (see page 1, DoubleClick)". Applicant further asserts that DoubleClick mentions only the clickTag variable as being a part of the ad Flash file, *which variable must be added to the ad Flash file by a person editing the ad Flash file*. Examiner could not understand how applicant came to such conclusion. DoubleClick does not a person referred to a designer in must edit the ad Flash file to include a "clicktag" variable.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Macromedia/Adobe Flash Trafficking Guide (DFA).

How to target variables in a Flash Player 5 movie,

http://kbe.adobe.com/cps/140/tn_14087_html (6 of 6)

Macromedia Flash Trafficking Guide.

Macromedia Unveils Macromedia Flash MX, Press Room 2002 Press Releases; March 4,

2002.

Rich Media Advertising Resource Center; Tracking Macromedia Flash (SWF) Movies,

Ad.

Yahoo! Flash Banner Standards for Designers.

Flash Ads on Yahoo!

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The

examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR
/Yehdega Retta/
Primary Examiner, Art Unit 3622